THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte DANIEL S. VENOLIA

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Appeal No. 95-4809
Application 08/104,251[1]

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ON BRIEF

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Before CARMICHAEL, HECKER and DIXON, **Administrative Patent Judges.**

DIXON, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1, 5-8, 10-13 and 15, which are all of the claims pending in this application.

[1]Application for patent filed August 9, 1993. According to appellant, this application is a continuation of application 07/811,830, filed December 20, 1991, now abandoned.

BACKGROUND

The present invention relates to a method of accessing a data field for use in a computer system. A cursor is used for dual purposes of computer cursor control and access control to a data field displayed by the computer system. The computer remaps the cursor control to control access to the data within the field. After remapping, the input device controls both the resolution and range of the data field displayed. Movements of the input device in a plane along one axis control the resolution, and movements in the other axis control the range of the data field for the display in response to the movement. The combined movements within the two axes simultaneously control resolution and range to access the data.

Appellant has indicated that claims 1, 5-7, 12, 13 and 15 stand or fall together, but claim 8[2] stands or falls together with claims 10 and 11. (Brief[3] at page 18.)

Independent claim 1 is representative of the invention and reproduced as follows:

> 1. In a computer system, a method for accessing a data field comprising the steps of:

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[2] Appellant has indicated that claim 8 stands alone and is grouped separately, but we have included claims 10 and 11 within the group due to their dependency on claim 8.

[3] Appellant filed a substitute appeal brief, October 13, 1998, (Paper No. 18) to replace the non-compliant appeal brief filed April 24, 1995, (Paper No. 14). We will refer to this substitute appeal brief as simply the brief.

positioning a moveable cursor to locations on a display screen in response to movement of a cursor positioning device;

remapping control of said cursor positioning device from controlling a position of said moveable cursor to controlling both a scale and a segment of said data field for display on said display screen, wherein said cursor positioning device performs a dual function of controlling movement of said cursor and controlling said scale and said segment, depending on a signal indicated by a switch;

when control of said cursor positioning device is remapped:

increasing said scale at which the data field is displayed according to movement of said cursor positioning device in a first direction of a first axis, wherein sustained movement of said cursor positioning device in said first direction of said first axis continuously increases said scale at which said segment of said data field is displayed;

decreasing the scale at which said data field is displayed according to movement of said cursor positioning device in a second direction in the first axis, wherein continuous movement of said cursor positioning device in said second direction of said first axis continuously decreases said scale at which said segment of said data field is displayed;

controlling which segment of the data field is displayed according to movement of said cursor positioning device in a second axis, wherein continued movement of said cursor positioning device relative to said second axis causes successive segments of said data field to be displayed at the scale which is selected by movement of said cursor positioning device in said first axis.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Matthews	4,794,388	Dec. 27, 1988
Becker et al. (Becker)	5,136,690	Aug. 04, 1992 (effective filing date Aug. 07, 1989)

Claims 1, 5-8, 10-13 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Matthews in view of Becker.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the appellant, we make reference to the brief and answer[4] for the details thereof.

OPINION

After a careful review of the evidence before us we disagree with the Examiner that claims 1, 5-8, 10-13 and 15 are properly rejected under 35 U.S.C. § 103 and we will not sustain the rejection.

As a consequence of our review, we make the determinations which follow.

Turning to the rejection of independent claim 1, we find that the examiner has not met the burden of setting forth a ***prima facie*** case of obviousness in rejecting claim 1. As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." ***In re Hiniker* Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). The claim sets forth "remapping control of said

[4] The Examiner responded to the brief with an examiner's answer mailed October 29, 1998, (Paper No. 19). We will refer to this second examiner's answer as simply the answer.

cursor positioning device from controlling a position of said moveable cursor to controlling both a scale and a segment of said data field . . . wherein said cursor positioning device performs a dual function." Further, claim 1 sets forth controlling parameters "according to movement of said cursor positioning device" and "wherein sustained movement of said cursor device . . . continuously increases [decreases] said scale" and "controlling which segment of the data field is displayed according to movement of said cursor positioning device in a second axis."

It is clear that the claimed invention controls the manipulation of the data through the movement of the cursor positioning device and that the cursor positioning device must be "remapped" prior to the manipulation of the data. The specification defines remapping at page 11. The specification states :

> "In the currently preferred embodiment, the mouse not only controls a cursor position on a display screen, but it can also be made to control two different parameters. The way in which this is accomplished is by 'remapping' the mouse's axes from controlling the x and y-axes cursor movements to, instead, controlling two parameters. When an axis is remapped to a parameter, motion in that axis no longer moves the cursor. Instead, it controls the parameter.
>
> By disassociating the axis of the mouse from the cursor, the mouse movement is not constrained by the edges of the display screen." (See specification at page 11.)

We have reviewed the rejection set forth by the Examiner in the answer at pages 3-5 and the response to the arguments that the Examiner has made at pages 5-6 of the

answer. We disagree with the Examiner's conclusion with respect to the combined teachings of Matthews and Becker. Assuming arguendo that the references are properly combined, we do not find that the combination of the two teachings would have fairly suggested the invention as claimed.

We disagree with the Examiner's characterization that Becker suggests controlling the resolution in response to movement along one axis and controlling range in response to movement along a second axis. Becker clearly discloses that the plural sliders are operated by use of the mouse in a "conventional manner" to select discrete input values by placement of the cursor on the slider and actuation of the mouse buttons. (See col. 2.) Clearly, this teaching does not teach nor fairly suggest to skilled artisans that the values are responsive to movement of the cursor device as the Examiner suggests. Rather, the input is responsive to the position/location at the time of actuation of the mouse button. We conclude that at most the combination of teachings would have suggested to skilled artisans to have a second specialized input device as Matthews teaches having two dimensional control of resolution and range.

Appellant has argued that there is no suggestion to modify the existing control for the dual purpose. (See brief at pages 23, 24 and 27.) We agree. The Examiner has not

provided a teaching nor motivation as to why it would have been obvious to one of ordinary skill in the art at the time of the invention to "remap" the conventional cursor control device to control the resolution and range "continuously" in response to "movement" along two axes of motion thereby providing dual functions or states of the single cursor control device.

With respect to claim 12, we note that this claim contains the additional limitation that the movements within the two axes "simultaneously vary said resolution and said range of display, until the particular piece of data is accessed." The Examiner has acknowledged the prior art does not teach the limitation, but the Examiner does not provide a line of reasoning as to why the applied references would have fairly suggested simultaneously varying resolution and range in response to movement. (See answer at page 4.)

Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in

the factual basis for the rejection. ***See In re Warner***, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), ***cert. denied***, 389 U.S. 1057 (1968). Our reviewing court has

repeatedly cautioned against employing hindsight by using appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. ***See, e.g., Grain Processing Corp. v. American Maize-Products Co.***, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). We conclude that the combination of elements taught by Matthews and Becker would not have produced the invention as claimed. Furthermore, to combine the teachings as asserted by the Examiner to reach the conclusions asserted by the Examiner concerning obviousness clearly appears to be impermissible hindsight reconstruction of the claimed invention rather than reasonable extension of the teachings of the prior art applied against the rejected claims. (See answer at pages 4-6.)

Since the limitations of independent claims 1 and 12 are neither taught nor suggested by the applied prior art, we cannot sustain the Examiner's rejection of these appealed claims under 35 U.S.C. § 103.

Therefore, it follows that we also cannot sustain the Examiner's rejection of appealed claims 5-8, 10, 11, 13 and 15 which depend therefrom, under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the Examiner rejecting claims 1, 5-8, 10-13 and 15 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES T. CARMICHAEL Administrative Patent Judge	)	
STUART N. HECKER Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOSEPH L. DIXON Administrative Patent Judge	)	

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